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09/466,813	12/20/1999	MASATOSHI KUMAGAI	PM265486	1620

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PILLSBURY WINTHROP, LLP  
P.O. BOX 10500  
MCLEAN, VA 22102

EXAMINER

BLAIR, DOUGLAS B

ART UNIT	PAPER NUMBER
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2142

12

DATE MAILED: 07/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/466,813

Examiner

Douglas B Blair

Applicant(s)

KUMAGAI ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

***Response to Amendment***

1. Claims 1-24 are pending in this application.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. As to claim 1, it is unclear how an electronic mail can have "a recipient of an intended recipient".

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C.

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122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1-4, 10-13, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number 6,449,657 to Stanbach Jr. et al..

8. As to claim 1, Stanbach teaches an SMTP server arranged to send an electronic mail having a an intended recipient to a server that receives and manages the mail (col. 9, lines 26-42), comprising: an advertisement information memory operable to store advertisement information to be added to the mail (col. 11, lines 63-67 and col. 12, lines 1-16); a user information memory operable to store a plurality of mail addresses and a plurality of pieces of personal information about users for the plurality of mail addresses so as to be associated with each other, respectively (col. 9, lines 42-67 and col. 10, lines 1-14); an advertisement information detector operable to detect the advertisement information which is to be added to the mail that is associated with at least one of user information about a user having the recipient mail address, user information about a user having a sender mail address and a sentence included in the mail (col. 10, lines 15-39); an advertisement information adding portion operable to add at least the advertisement information, which is detected from the memory by said advertisement information detector to the mail (col. 14, lines 31-47); and a sending portion operable to send the mail, on which the advertisement information is added by the advertisement information adding portion, to the server (col. 10, lines 64-67 and col. 11, lines 1-10).

9. As to claim 2, Stanbach teaches the SMTP server of claim 2, wherein the advertisement information includes page-specifying information that specifies a predetermined homepage (col. 14, lines 30-47).

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10. As to claim 3, Stanbach teaches the SMTP server of claim 2, wherein the advertisement information memory stores the advertisement information and personal information about a user who is an object for which addition of said advertisement information is performed so as to be associated with each other (col. 11, lines 11-34), the advertisement information detector detects the personal information associated with the mail address of the recipient of the mail from the user information memory (col. 11, lines 11-22), and detects the advertisement information associated with said detected attributed information from the advertisement memory (col. 11, lines 11-50).

11. As to claim 4, Stanbach teaches the SMTP server of claim 3, wherein the attribute information is at least one of age, gender and a zip code (col. 12, lines 17-39).

12. As to claims 10-13, Stanbach's invention could be embodied as a POP server (col. 9, lines 26-42). All other limitations from claims 10-13 are rejected on the same basis as claims 1-6.

13. As to claim 18, its limitations are featured in claim 1, thus it is rejected on the same basis as claim 1.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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15. Claims 5-9 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,449,657 to Stanbach, Jr. et al. in view of U.S. Patent Number 6,360,221 to Gough et al..

16. As to claim 5, Stanbach teaches the SMTP server of claim 4, however Stanbach does not teach an advertisement refusal system.

Gough teaches a mail system comprising: an addition refusal information memory, operable to store addition refusal information specifying a mail address that refuses the addition of the advertisement; and an addition controller operable to stop the addition of the advertisement information by the advertisement information adding portion to the mail, in a case where the mail address specified by the addition refusal information is the mail address of the recipient of the mail (col. 6, lines 12-39).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Stanbach regarding a email advertisement system with the teachings of Gough regarding an advertisement refusal option because such a service could be profitable (Gough col. 6, lines 12-39).

17. As to claim 6, Stanbach teaches the SMTP server of claim 5, further comprising a target key word memory, operable to store the advertisement information and a key word to be included in a sentence of a mail to which said advertisement information is added, so as to be associated with each other (col. 11, lines 23-34), wherein the advertisement information detector detects advertisement information that is associated with a key word corresponding to a phrase included in a sentence of the mail to be sent (col. 11, lines 23-34).

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18. As to claim 7, Stanbach teaches a the SMTP server of claim 6, including a key word memory operable to the advertisement information and a key word to be included in a sentence of a mail to which said advertisement information is added; however, Stanbach does not explicitly teach the removal of advertisement information based on the presence of a keyword.

Stanbach teaches the removal of advertisement information from a mail passed on the presence of demographic information in an email (col. 14, lines 48-67 and col. 15, lines 1-12).

It would have been obvious to one of ordinary skill in the computer Networking art at the time of the invention to combine the teachings of Stanbach regarding the use of keywords with the teachings of Stanbach regarding the removal of advertisement information because certain advertisers may not want advertisements added to emails with certain words (col. 14, lines 48-67 and col. 15, lines 1-12).

19. As to claim 8, Stanbach teaches an SMTP server wherein the mail has plurality of mail addresses of recipients, the sending portion sends the mail to each of the mail addresses of the recipients when the mail has the plurality of mail addresses of the recipients (col. 10, lines 64-67 and col. 11, lines 1-22), the advertisement information detector detects the advertisement information to be added to the mail that is to be sent to each of the mail addresses (col. 11, lines 11-34), based on the attribute information of the user corresponding to each of the mail addresses (col. 11, lines 11-22), and the advertisement information to the mail that is sent to each of the mail addresses of the recipients (col. 11, lines 11-50).

20. As to claim 9, Stanbach teaches an SMTP server comprising: a point information memory operable to store a mail address and point information for a user having said mail address to be associated with each other; and a point updating portion operable to update the

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point information associated with the mail address of the sender of the mail, when the advertisement information adding portion adds the mail to the advertisement information (col. 14, lines 48-62).

21. As to claims 14-17, Stanbach's invention could be embodied as a POP server (col. 9, lines 26-42). All other limitations from claims 14-17 are rejected on the same basis as claims 5-9.

22. Claims 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,449,657 to Stanbach, Jr. et al. in view of U.S. Patent Number 6,360,221 to Gough et al. and U.S. Patent Number 6,014,502 to Moraes.

23. As to claim 19, Stanbach teaches a mail processing system comprising a mail server operable to send a mail having a recipient mail address of an intended recipient to a server that receives and stores the mail, wherein the mail server includes: an advertisement information memory operable to store advertisement information to be added to the mail (col. 11, lines 63-67 and col. 12, lines 1-16); a user information memory operable to stored a plurality of mail addresses and a plurality of pieces of personal information about users for the plurality of mail addresses so as to be associated with teach other (col. 9, lines 42-67 and col. 10, lines 1-14), respectively; an advertisement information detector operable to detect advertisement information, which is to be added to the mail that is associated with at least one of: (a) user information about a user having recipient mail address, (b) user information about a user having a sender mail address corresponding to a sender of the mail, and (c) a portion of a message in the mail from the advertisement information memory; an advertisement information adding portion operable to add the advertisement information, which is detected from the advertisement



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information memory by said advertisement information detector, to the mail (col. 11, lines 63-67 and col. 12, lines 1-16); and a sending portion operable to send the mail, to which the advertisement information is added by said advertisement information adding portion, to the server, wherein the server includes: a reception portion operable to receive an adding request of advertisement information to the mail from the terminal (col. 10, lines 64-67 and col. 11, lines 1-10); however Stanbach does not explicitly teach a client program for requesting the addition of advertisement information to emails, a web server including a reception portion operable to send the mail to the server, or a web server operable to send a predetermined program to a terminal based on a request from the terminal.

Gough teaches a program on a terminal, from which the adding request is received, so that the mail, which is to be sent to the recipient mail address from the terminal, is sent to the mail server that adds the advertisement and a web server including a reception portion operable to receive an adding request of advertisement information to the mail from the terminal (col. 4, lines 1-21, The user requests that "enhancements" be added to the mail at the server.).

Moreas teaches a web server operable to send a predetermined program to a terminal based on a request from the terminal (col. 10, lines 44-64).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Stanbach regarding a system for inserting advertisements in an email at a server with the teachings of Gough regarding the requesting that a server make additions to email at a server because requesting that information be added to an email increases the enjoyment of email experiences (Gough col. 1, lines 53-67 and col. 2, lines 1-5). It would have been obvious to one of ordinary skill in the Computer Networking art at the

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time of the invention to combine the teachings of Stanbach regarding a system for inserting advertisements in an email at a server with the teachings of Moreas regarding a server carrying out a request for a program from a terminal because sending a program to a user facilitates the use of an email advertisement system (Moreas col. 10, lines 37-42).

24. As to claim 20, Stanbach teaches a mail processing system, wherein the advertisement information adding portion of the mail server adds to the mail, advertisement information including user specifying information that specifies a user of the mail, address of the recipient of the mail, and link information that makes the terminal used by the user send the user specifying information to the web server when an instruction by the user occurs (col. 14, lines 48-62), the web server or the mail server includes a point information memory operable to a mail address, and point information of a memory operable to a mail address, and point information of a user having said mail address to be associated with each other (col. 10, lines 64-67 and col. 11, lines 1-10), the web server further includes: a user specifying information receiving portion operable to receive the user specifying information sent from the terminal by the link information sent from the terminal by the link information; and a point updating portion operable to update, based on the user specifying information received by the user specifying information receiving portion, the point information of the corresponding user (col. 10, lines 64-67 and col. 11, lines 1-10).

25. As to claim 21, Stanbach teaches a mail processing system wherein the advertisement information adding portion in the mail server adds to the mail advertisement, specifying information that specifies an advertiser of the advertisement information, and link information that makes a terminal used by the user having the mail address of the recipient of the mail send the advertisement specifying information to the web server when an instruction of said user

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occurs (col. 10, lines 64-67 and col. 11, lines 1-10), the web server or the mail server includes a charging information memory operable to store information specifying an advertiser and charging information about charging on said advertiser (col. 14, lines 63-67 and col. 15, lines 1-12), the web server further includes: an advertisement specifying information receiving portion operable to receive the advertisement specifying information sent from the terminal by the link information (col. 10, lines 64-67 and col. 11, lines 1-10); and a charging information updating portion operable to update based on the advertisement specifying information received by the advertisement specifying information receiving portion, the charging information of a corresponding advertiser (col. 14, lines 63-67 and col. 15, lines 1-12).

26. As to claim 22, Stanbach teaches a mail processing system wherein the web server or the mail server includes a charging information memory operable to store advertisement specifying information that specifies an advertiser, charging information about charging on said advertiser (col. 14, lines 63-67 and col. 15, lines 1-12), and address information of an advertisement homepage to be presented to a user of a terminal, so as to be associated with one another, the advertisement information adding portion adds to the mail advertisement, specifying information that specifies an advertiser of the advertisement information (col. 14, lines 30-47), and link information that makes the terminal send the advertisement specifying information to the web server in a case where an instruction of the user of the terminal occurs, the web server includes: an advertisement specifying information receiving portion operable to receive the advertisement specifying information sent from the terminal by the link information (col. 10, lines 64-67 and col. 11, lines 1-10); an instruction information memory controller operable to control the terminal that sent the advertisement specifying information, to store instruction information

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indicating that an instruction by the user occurred (col. 10, lines 64-67 and col. 11, lines 1-10); and a homepage retrieval controller operable to detect, based on the advertisement specifying information received by the advertisement specifying information received by the advertisement specifying information receiving portion, the address information of the advertisement homepage associated with the advertisement specifying information and to control the terminal to retrieve the advertisement homepage having said address information (col. 14, lines 30-47).

27. As to claim 23, Moreas teaches a confirmation receiving portion operable to receive confirmation that the instruction information is stored in a terminal that requested a pre-determined target homepage that is linked to the advertisement homepage (col. 6, lines 41-65); and a goal achievement charging updating portion operable to update, based on receipt of the confirmation, the charging information associated with an advertisement specifying information of an advertiser of the target homepage indicated by the confirmation (col. 6, lines 41-65).

28. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,360,221 to Gough et al. in view of U.S. Patent Number 6,014,502 to Moraes and U.S. Patent Number 6,449,657 to Stanbach, Jr. et al..

29. As to claim 24, Gough teaches a method for enabling a terminal to send mail, comprising: receiving a request to add advertisement information to a mail from the terminal by a web server and a program in the terminal for enabling the terminal to send a recipient addressed mail to a mail server that adds advertisement information to the mail (col. 4, lines 1-21, The user requests that "enhancements" be added to the mail at the server.); however Gough does not explicitly teach sending a program to a terminal and installing that program or the

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advertisement information being associated with at least one of user information or a portion of a message in the mail.

Moreas teaches sending an email program to a terminal and installing that program (col. 10, lines 44-64).

Stanbach teaches adding advertisement information associated with a portion of a message in an e-mail (col. 9, lines 56-67 and col. 10, lines 1-14).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Gough regarding the requesting that a server make additions to email at a server with the teachings of Moreas regarding a server carrying out a request for a program from a terminal because sending a program to a user facilitates the use of an email advertisement system (Moreas col. 10, lines 37-42). It would have been further obvious to one of ordinary skill in the Computer Networking art to combine the teachings of the Gough-Moreas combination regarding a program for adding advertisement information to e-mails with the teachings of Stanbach regarding associating advertisement information with a portion of a message because such a technique better provides more targeted advertising (Stanbach, col. 11, lines 35-63)

### ***Response to Arguments***

30. Applicant's arguments filed 5/16/2003 have been fully considered but they are not persuasive. The applicant argues the following points: (a) Because the memory of claimed arrangement stores the user's personal information, the advertisement information detector does not need to establish "demographic profile" as in Stanbach et al.; (b) Gough et al. does not have

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“an advertisement information adding portion operable to add the advertisement information, which is detected from the advertisement information memory by said information detector, to the mail; and sending portion operable to send the mail, to which the advertisement information is added by said advertisement information adding portion, to the server”; and (c) Neither Moraes nor Gough et al. disclose “installing the program in the terminal for enabling the terminal to send a recipient addressed mail to a mail server that adds the advertisement information, which is associated with at least one of: user information about a user having the recipient mail address, user information about a user having a sender a mail address corresponding to a sender of the mail, and a portion of a message in the mail to the mail”.

31. As to point (a), the Stanbach et al. invention also stores a user's personal information (col. 9, lines 43-48). This information is used to create the demographic information (col. 9, lines 56-67 and col. 10, lines 1-14).

32. As to point (b), the rejection of claim 1 involving Gough has been withdrawn so this argument is moot.

33. As to point (c), this argument is considered moot because of new grounds of rejection necessitated by amendment.

### ***Conclusion***

34. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

35. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas B Blair whose telephone number is 703-305-5267. The examiner can normally be reached on 8:30am-5pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Powell can be reached on 703-305-9703. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3800.

Douglas Blair  
July 24, 2003

DBB



MARK POWELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100